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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,573	02/20/2002	Isao Echizen	500.41219X00	5074

24956 7590 05/09/2005

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EXAMINER

PATEL, SHEFALI D

ART UNIT	PAPER NUMBER
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2621

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/078,573	Applicant(s) ECHIZEN ET AL.	
	Examiner Shefali D. Patel	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 9-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/27/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of species I (i.e., claims 1-8) in the reply filed on March 16, 2005 is acknowledged.
2. Claims 9-19 are withdrawn from consideration and should be cancelled accordingly.

Information Disclosure Statement

3. The information disclosure statement filed on January 27, 2005 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because copy of reference "Data Hiding Based on Neighbor Statistics" is not provided. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).
4. The information disclosure statement filed on January 27, 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. A copy of the reference "Data Hiding Based on Neighbor Statistics" is not provided.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claim 7 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 7 is non-statutory because the terminology "...program for detecting information inserted as a digital watermark from contents, comprising codes for executing..." alone has no set definition.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1-2, 5-6, and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Ogino (US 6,802,011).

With regard to **claim 1** Ogino discloses a digital watermark information detection method for detecting information inserted as a digital watermark from contents (Figure 1), comprising: a first step of converting said contents into a predetermined specified format (col. 8 lines 1-20 and 29-47. Converting the 480I format into 480P format using the predetermined formats at col. 8 lines 1-20); and a second step of trying to detect information from said converted contents (col. 8 lines 52-60).

With regard to **claim 2** Ogino discloses a digital watermark information detection method according to claim 1 as disclosed above, wherein when a plurality of specified formats are defined in advance (col. 8 lines 29-36, col. 10 lines 35-41) and detection of the information from said converted contents fails (if the detection fails and the system forbids from copying, col. 9 lines 46-52), said contents is converted into a specified format other than that used in said first step to retry detection of the information (col. 9 lines 25-32 and 53-65).

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With regard to **claim 5** Ogino discloses a specified format is defined with respect to each format of the contents (col. 8 lines 29-36 and col. 10 lines 35-41).

Claim 6 recites identical features as claim 1 except claim 6 is an apparatus claim. Thus, arguments similar to that presented above for claim 1 is equally applicable to claim 6. Note the apparatus disclosed in Figure 1.

With regard to **claim 8** Ogino discloses embedding method (at col. 7 lines 49-59) acquiring information of a specified format used in the course of detection of digital watermark information (by reading unit 11, col. 7 lines 60-63); acquiring a conversion rule used for conversion of the present format into said specified format (col. 8 lines 21-36); and embedding the watermark information such that the watermark information is not lost even when said conversion rule is applied (when conversion is applied the watermark is still there giving status of "copy once," "never copy," "copy free," col. 9 lines 35-52).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogino (US 6,802,011) in view of Walker et al. (hereinafter, "Walker") (US 6,785,401).

With regard to **claim 3** Ogino discloses the digital watermark information detection method as disclosed above in claims 1-2 and the arguments are not repeated herein, but are incorporated by reference. Ogino does not expressly disclose priority orders set in advance to plurality of specified formats and first and second steps are repeated in accordance with the priority orders until the information detection succeeds. Walker discloses this at col. 9 lines 57 to col. 10 lines 1-27. Ogino and Walker are

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combinable because they are from the same field of endeavor, i.e., digital watermarking. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine the teaching of Walker with Ogino. The motivation for doing so that the watermark decoder effectively decodes the watermark with the higher hierarchy synchronization vector, effectively erasing the lower hierarchy watermark as suggested by Walker at col. 3 lines 14-19. Therefore, it would have been obvious to combine Walker with Ogino to obtain the invention as specified in claim 3.

With regard to **claim 4** Walker discloses the priority orders of said plurality of specified formats are updated in accordance with the number of successful information detection operations (col. 10 lines 2-8).

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US 6,055,564 – Admission control where priority indicator is used to discriminate between messages

US 6,674,858 – Receiving, recording, and reproducing device for broadcast signal

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shefali D. Patel whose telephone number is 571-272-7396. The examiner can normally be reached on M-F 8:00am - 5:00pm (First Friday Off).


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh M. Mehta can be reached on (571) 272-7453. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shefali D Patel
Examiner
Art Unit 2621

April 29, 2005



BHAVESH W. MEHTA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600